

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration of this application, as amended, and reconsideration of the Final Office Action dated August 4, 2005. Upon entry of this amendment, Claims 1-11, 13-18, and 20-22 remain pending in this application. Support for the Amendment is found in the claims as originally presented. No new matter has been incorporated by this Amendment.

It is respectfully submitted that the learned Examiner is figuratively combining apples and oranges and calling the result a peach, yet the result is neither. In other words, there is no motivation to combine the references cited by the learned Examiner. Reference is made to MPEP 2143.01(v), where it is stated "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), and to MPEP 2143.01(vi) where it is stated "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (C.C.P.A. 1959).

Yang discloses a safety ball. There is nothing in the disclosure to indicate that the ball is intended as a competitive ball. To modify *Yang* as done by the Examiner by removing the outer "soft" layer would modify *Yang* from its intended purpose as a safety ball and yield a hard ball that would be capable of harming users, especially children, contrary to the principles of operation set forth in *Yang*. Thus, the rejection of Claims 1, 6, 11, and 22 under 35 U.S.C § 103(a) is improper and is due to be withdrawn.

Talarico also discloses a safety ball, whose structure is exactly reversed from *Yang*, requiring a soft core, hard first layer and an optional wound layer all overlain by an outer cover. There is nothing in either *Yang* or *Talarico* that teaches, suggests or motivates one to diametrically alter the other. Each claims to provide a safety ball by completely different means, to wit a soft core in *Talarico* and a hard core in *Yang*. Neither are intended as competitive or regulation balls and neither can be modified to yield the present invention without ignoring the principles of operation of the cited references, which is improper. Thus, the rejection of Claims 2, 4, 5, 7-10 and 14-18 is respectfully submitted to be improper and is due to be withdrawn.


The final reference cited by the learned Examiner is *Walker* which discloses a ball with a reduced flight distance whereas the claimed invention is a competitive ball which is not a reduced flight distance ball, hence *Walker* is improperly applied. Structurally, *Walker* does not employ a core and mantle layer but rather has a core 12 which has COR less than the COR required in the claims, to which a cover 14 is stitched. An optional sealant 14 may be applied to the cover. As noted, the *Yang* and *Talarico* references are directed to a safety ball which are not competitive balls as required in the present invention. Thus, each of the references would have to be modified contrary to their intended purpose and contrary to their principles of operation, thus they are not properly applied under Section 103 since there is no motivation present or properly derived for such modification.. Accordingly, the rejection of Claim 1 as amended by the incorporation of the limitations of Claim 12, 3, 13, 14 as amended, 20 and 21 is improper and is due to be withdrawn.

Yang requires a core with "great hardness and great density" with absolutely no quantification of the meaning of the term. The Examiner has specifically stated that *Talarico* is relied on merely for its teaching that it is well known in the art of game balls to use Polyurethane. Thus, *Talarico* cannot be relied on for the specific limitations of the claims. Likewise, the Examiner stated that *Walker* is relied on merely as teaching that it is well known to foam polyurethane foam from a mixture of 100 parts polyol to 33-40 parts isocyanate. However, the teachings of *Walker* call for a soft core (12) having and a co-efficient of restitution of between 0.30 and 0.40 (col. 3, lines 28-31 and col. 4, lines 57-61), and a cover (14) thereby yielding a ball with reduced flight characteristics rather than a competitive ball. *Walker* does not use multiple layers and teaches a "soft" softball only useful in restricted areas and not as a competitive ball. Thus, by the Examiner's own statement, the references cannot possibly teach or suggest the combination of hardness and compression required by the instant claims for a competitive ball.

In view of the above amendments, a favorable response and an early issuance of the case is earnestly solicited.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: 
Robert J. Veal, Reg. No. 30,895

Suite 3100, Promenade II
1230 Peachtree Street, N.E.
Atlanta, Georgia 30309-3592
Telephone: (404): 815-3770
Facsimile: (404): 685-7070